

PATENT

SUMMARY OF INTERVIEW

Exhibits and/or Demonstrations

No exhibits or demonstrations were presented.

Identification of Claims Discussed

Claims 1, 14, 21, and 25 (all the independent claims) were discussed.

Identification of Prior Art Discussed

U.S. Patent No. 2,403,277 to Hall and U.S. Patent No. 2,286,904 to Ewald were discussed as not teaching or suggesting anything about facial indicia having a functional aperture.

Proposed Amendments

No amendments were proposed.

Principal Arguments and Other Matters

During the interview, Applicants argued that the Examiner has not provided any reference teaching facial indicia associated with a reel housing, let alone facial indicia having an aperture that performs a function (*e.g.*, Claim 1 recites an aperture sized to closely surround spoolable linear material – the aperture guides the linear material into the appropriate areas of the reel). Furthermore, even if the Examiner does provide such a reference, Applicants noted that a specific motivation or suggestion, in the prior art, to combine such references has not been provided. Applicants argued that recited functionality of the facial indicia (*e.g.*, a functional aperture in the facial indicia) renders the element more than an “ornamental design,” as stated by the Examiner. Applicants also outlined the holding of *In re Dembiczak*, 50 U.S.P.Q. 2d 1614 (Fed. Cir. 1999) and applied this holding to the facts of the present case. Specifically, among other arguments, Applicants stressed that referring to Applicants’ functional facial indicia as “an obvious matter of ornamental design choice...based on ornamental preference, providing no new or unexpected results” is not the obviousness standard mandated by the Federal Circuit. Instead of “[b]road conclusory statements,” the Examiner must provide “clear and particular” evidence of a suggestion or motivation to combine. *Id.* at 1617. Applicants also argued that, as the facts of the present case are similar to those in *In re Dembiczak*, a similar analysis is appropriate in the

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present case. Applicants noted that, if anything, the present rejection is even weaker than that of In re Dembiczak, since, here, the Examiner has not cited references that collectively include all of the limitations of the claimed invention.

The Examiner noted that Applicants already had a related design patent on a similar reel. In response, Applicants directed the Examiner's attention to the structure and functionality recited in Applicants' claims.

Results of Interview

The Examiner agreed that none of the references of record taught or suggested facial indicia, which Applicants noted was required for a *prima facie* case. However, the Examiner did not make a decision as to allowability of the claims. The Examiner stated that he might still find that Applicants' recited facial indicia are an obvious matter of ornamental design choice. Furthermore, although the Examiner recognized the applicability of In re Dembiczak, he thought that, in that case, the fact that the trash bags expanded into a pumpkin shape when filled pushed a close case over the line into allowability. The Examiner was unsure as to whether the recited functionality of the facial indicia in the present application rises to the same level.

Applicants agreed to send in a Request for Reconsideration outlining the arguments presented during the interview.

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REMARKS

Applicants thank the Examiner for the courtesy of granting Applicants' representative, Demian Jackson, a phone interview on December 8, 2003. The subject matter of this interview is summarized above. Applicants herein further detail the deficiencies of the Examiner's rejections discussed during the interview. The arguments contained herein are not new, but instead further clarify arguments made in greater detail in Applicants' prior responses. Accordingly, Applicants respectfully ask the Examiner to reconsider the current rejections.

Requirements for a *Prima Facie* case of Obviousness

In order to support an obviousness rejection an Examiner has the burden of providing a *prima facie* case which must include *two showings*. First, the Examiner must provide teachings from the art which collectively teach each and every recited limitation. Second, the Examiner must provide a motivation or suggestion to combine the references. If *either* of these two showings is absent or deficient, the obviousness rejection *cannot stand*.

First Showing: Art Teaching or Suggesting Each and Every Feature

With regard to the first showing, Applicants respectfully submit that the Examiner has not provided references which teach each and every limitation recited in the claims. Namely, the Examiner has not provided any reference which teaches or suggests facial indicia associated with a reel, much less facial indicia having an aperture sized to closely surround spoolable linear material extending through the aperture. Accordingly, it follows that the obviousness rejection is improper without even considering the second showing.

Second Showing: Specific Suggestion or Motivation to Combine from the Art

Even if the Examiner does provide a reference teaching facial indicia having an aperture for linear material, the Examiner must show that the prior art contains a specific motivation or suggestion to combine such teaching with a conventional reel. In place of the required specific suggestion from the art, the Examiner has instead continued to apply the following incorrect obviousness standard: "the ornamental design of the exterior of the access panel would have been an *obvious matter of ornamental design choice* to a person having ordinary skill in the art *based on ornamental preference, providing no new or unexpected results*." Office Action at p.2; See

also, p. 3. This is *not* the standard for obviousness under 35 U.S.C. § 103(a). Whether the Examiner considers Applicants' recited elements to be an "ornamental preference" is irrelevant to fulfilling the requirement of providing a specific suggestion or motivation to combine. Under 35 U.S.C. § 103(a), "the showing [of obviousness] must be *clear and particular*," and "[b]road *conclusory statements* regarding the teaching of multiple references, standing alone, *are not 'evidence.'*" *Id.* at 1617 (*emphasis added*). Stating that a recited functional limitation is "an obvious matter of design choice" is *not* a clear and particular showing. Furthermore, it is improper for the Examiner to suggest or ask that Applicants show "new or unexpected results" unless the Examiner has *first* presented a *prima facie* case of obviousness, a burden that the Examiner has not met in the present case. Applicants claim a reel housing including facial indicia having an aperture that performs a function (*e.g.*, Claim 1 recites an aperture sized to closely surround spoolable linear material, the aperture guiding the linear material into the appropriate areas of the reel). The Examiner has yet to provide any suggestion or motivation to modify a conventional reel to include this recited limitation. Thus, the Examiner has not met the second required showing of a *prima facie* case of obviousness. Accordingly, Applicants submit that all pending claims are in condition for allowance and respectfully request the same.

Applicability of the logic of *In re Dembiczak*

In the prior Response, Applicants stressed the applicability of *In re Dembiczak* to the present case in greater detail. *See*, Amendment and Response to Office action at pp. 5-7. Applicants note that, in the *Dembiczak* case, the Board's obviousness rejections were overruled by the Federal Circuit even though the Board's obviousness case was stronger than that of the present case. The Examiner in *In re Dembiczak* cited prior art (*i.e.*, conventional trash bags and children's art references) collectively including each and every limitation of the claimed pumpkin bags, but the Examiner failed to provide a *clear and particular showing* of a suggestion or motivation to combine. In the present case, the Examiner has not even met the first of the two required showings of a *prima facie* case of obviousness.

The Examiner has indicated that, in *Dembiczak*, the shape that the claimed trash bags assume when filled ("the form and general appearance of a pumpkin") tipped a close case to allowability. Applicant disagree with this characterization of *Dembiczak*. *In re Dembiczak* stands for the proposition that, absent a specific motivation or suggestion to do so, adding facial

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indicia to conventional trash bags is non-obvious. It was the Examiner's failure to provide a clear and particular motivation or suggestion to combine that rendered the invention nonobvious. Applicants respectfully ask the Examiner to identify the portion of the Court's opinion in In re Dembiczak that indicates that the shape of the trash bags when filled was determinative, rather than the Examiner's failure to provide the required suggestion to combine.

Applicants fail to understand how the present case is materially different than the facts of Dembiczak, aside from the fact that the cited references in the present rejections do not collectively include each and every limitation of the pending claims. In Dembiczak, the applicant essentially claimed a trash bag decorated with facial indicia and which has the "form and general appearance of a pumpkin" when filled. The only relevant issue was whether there was a suggestion to combine. The court did not discuss whether the combination included all of the claim limitations. The court's analysis would have applied with equal effect whether or not the combination included all of the claim limitations. Arguably, even a conventional trash bag has the form and general shape of a pumpkin (i.e., slightly rounded and oval) when filled. The fact that the claimed trash bags in Dembiczak assumed a pumpkin shape when filled does not change the fact that the applicant merely added facial indicia to a conventional product. In the present application, Applicants claim a reel housing having facial indicia. Absent a suggestion or motivation in the prior art for modifying a conventional reel housing to have facial indicia, these facts alone are analogous to Dembiczak. Furthermore, Applicants' claims additionally recite that the facial indicia includes an aperture for performing a function (e.g., Claim 1 recites an aperture sized to closely surround spoolable linear material). Thus, if anything, Applicants claimed facial indicia are even more functional than those of Dembiczak.

In any event, by failing to provide references teaching each and every element of Applicants' recited invention, the Examiner has not met his burden of to provide a *prima facie* case of obviousness. Furthermore, even if such a reference is provided, the Examiner must show a clear and particular motivation or suggestion to combine such references. Accordingly, Applicants submit that all pending claims are in condition for allowance and respectfully request the same.

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CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully request that the Examiner reconsider the rejections and allow the application. If, however, some issue remains that the Examiner feels can be addressed by Examiner's amendment, the Examiner is cordially invited to call the undersigned for authorization.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 12 / 10 / 03

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